

### REMARKS/ARGUMENTS

The §103(a) rejection presented in the Office Action dated January 12, 2006 (hereinafter Office Action) has been considered. Claims 1-37 are pending. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2003/0100295 by Sakai *et al.* (hereinafter "Sakai") and further in view of U.S. Patent No. 6,529,737 to Skinner *et al.* (hereinafter "Skinner"). Applicant respectfully traverses the rejection because it fails to satisfy the requirements of a *prima facie* rejection under §103. In order to establish a *prima facie* case of obviousness, it must be shown that the asserted references, alone or in combination, teach or suggest all of the claimed limitations and that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references as asserted. MPEP §2142. Applicant respectfully traverses the rejection since the cited art fails to disclose all the claim limitations and no evidence of motivation to combine the references has been presented.

First, the asserted references, alone or in combination, fail to teach each of the claimed limitations. In reasserting Sakai as a basis for a §103(a) rejection, the Office Action acknowledges that Sakai fails to teach a control unit configured to save messages relating to unanswered calls and to constitute contact attempts from the messages relating to the unanswered calls. In an attempt to overcome this deficiency, the Office Action relies upon the teachings of Skinner. Applicant fails to recognize however, where Skinner teaches a control unit configured to constitute contact attempts from unanswered call data and messages relating to unanswered calls, as claimed. The Office Action does not assert that Skinner teaches such limitations and the cited portions of Skinner fail to teach such limitations. For example, the citation to column 2, line 57-column 3, line 7 (Background of Skinner) merely describes sending a text message to another's telephone. The cited portion at column 4, line 18-column 5, line 16, discloses that if a call is not answered, then an SMS message may be sent from the originator of the call to a subscriber (the called party). The

subscriber has the option to ignore the SMS message or send a return SMS message to the originator indicating the subscriber's intentions. Neither of these cited portions, nor any other portion of Skinner, teach the claimed constituting contact attempts. More specifically, Skinner fails to teach that if a call is not answered, then unanswered call data and a message relating to the call are combined together in the subscriber's terminal (*see, e.g.*, Claim 2).

Each of the independent claims (Claims 1, 10, 19 and 28) include limitations directed to constituting contact attempts from unanswered call data and messages relating to unanswered calls. The Office Action fails to assert, or identify, where Skinner teaches or suggests such limitations. Without a presentation of correspondence to each of the claimed limitations, a *prima facie* §103(a) rejection has not been established, and the rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

Second, the requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine these references is to "enable a subscriber screening calls due to an insufficient identification of an originator or an unavailable subscriber to decide whether to accept a call from an originator or respond at a later time." This is not a motivation to combine the cited references but rather, is a generalized statement of what is taught by Skinner. Moreover, it does not provide a reason to modify Sakai as Sakai already teaches a manner of identifying the originator of a call by displaying an image of the caller. No evidence has been provided that a skilled artisan would attempt to introduce additional ways of identifying a caller to the teachings of Sakai.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in either reference that leads to the combination of the references, and it is respectfully submitted that aspects purportedly found in the prior art have been pieced together to arrive at the invention through hindsight. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a

blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the asserted references – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Accordingly, Applicant requests that the rejection be withdrawn.

Dependent Claims 2-9 depend from independent Claim 1, dependent Claims 11-18 depend from independent Claim 10, dependent Claims 20-27 depend from independent Claim 19, and dependent Claims 29-37 depend from independent Claim 28. Each of these dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Sakai and Skinner. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 10, 19 and 28. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-9, 11-18, 20-27 and 29-37 are also allowable over the combination of Sakai and Skinner.


It is to be understood that Applicant does not acquiesce to the Office Action's characterization of the asserted art or Applicant's claimed subject matter, nor of the Office Action's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to the Office Action's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Office Action's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.044PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

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By: 

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